

Docket No. 10004809-1
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3. The Rejection of Claim 14 over Otaki in view of Coates

A *prima facie* case of obviousness has not been presented for claim 14 for lack of teaching of each and every element of the claim. Specifically, neither Otaki nor Coates teach a metallic foil. A metallic foil, as commonly known, is an independent, thin sheet of self-supporting metal that is separate and distinct from the other layers (Application page 7, lines 17-18). Claim 14 specifically claims a metallic foil layer. Foils should not be confused with metallic layers that are deposited on substrates, and which are not independent or self-supporting.

Otaki teaches only a hologram, and therefore, does not teach a metallic foil. Coates teaches metallic holograms comprising a thin layer of metal, which is always formed and mounted on a substrate (Abstract). Unlike the claimed foil, the metallic layer of Coates is necessarily very thin and is fabricated or deposited on a die or substrate which is then used for transferring purposes (See col. 2, lines 6-11). The methods of Coates, such as vacuum metallization, sputtering and vacuum depositing the thin layer of metal, would not create a foil (col. 2, lines 6-7, 15-17, and 27-29). The metal layers of Coates are not layers of foil, i.e., independent of the other layers and self-supporting metal, but rather are always formed and mounted on a substrate (Abstract, and col. 2, lines 8-10, 18-22, and 29-31).

The Examiner argues that there is nothing in Coates that suggests that the metal layer of Coates is not self-supporting after it has been formed. Respectfully, Applicant disagrees with the Examiner on this point. The fact that the metal layer of Coates is always formed and mounted on a substrate is evidence that it is not independent from the substrate and is also evidence that it is either too thin or not cohesive enough to support itself, and thereby does not qualify as a metallic foil. In addition, Coates expressly teaches extreme thinness of the metal hologram, and even states that:

"[T]his thinness is necessary... because the metal surface which was not in contact with the die surface will ultimately be the reflective holographic surface; and if the metal is much thicker, it will not adequately reproduce the detailed topology of the holographic master from which the die was fabricated." (col. 2, lines 42-49).

Contrary to the Examiner's position, Applicant submits that the facts discussed above do suggest that the metallic layer of Coates is not self-supporting after it has been formed.

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The Examiner argues that Coates is combined with Otaki to teach the use of a metallic hologram layer and not to teach the thickness of the hologram layer. Regardless of the purpose in combination, neither Coates nor Otaki teach a metallic foil. To reiterate, a metal foil is a layer that is independent and self-supporting. The procedures and methods taught in Coates necessarily prevent formation of a metal or holographic layer that is either independent or self-supporting. As such, Coates does not teach a metal foil.

As neither Coates nor Otaki teach a metallic foil layer, they do not teach each and every element either alone or in combination. Therefore, withdrawal of the rejection is requested.

4. The Rejection of Claims 36-48 over Otaki in view of Coates

A *prima facie* case of obviousness has not been presented for claims 36-48 for lack of teaching each and every element of the claim. Specifically, neither Otaki nor Coates teaches an image-free metallic layer, as is required in independent claim 36. In fact, Otaki does not even teach a metal hologram, as is acknowledged by the Examiner on Page 7 of the March 18, 2008 Office Action. Accordingly, without a metal hologram, Otaki cannot possibly have an image free metallic layer.

Coates does not make up for this deficiency. The Examiner alleges that the metallic layer of Coates is not imaged or embossed at all times. In response, Applicant submits that Coates does teach a metallic layer, but the metallic layer of Coates is always a metallic hologram. A hologram is generally known and accepted as a type of image, and thus by its very nature a metallic hologram comprises an image. Moreover, Coates expressly teaches an image replicated into a metallic film (col. 1, lines 31-32). Therefore, the metallic layer of Coates is not image-free.

In support of his argument that the metallic layer of Coates is image-free at times, the Examiner references col. 2, lines 5-15 of Coates, which describe one method of fabricating the metal hologram. The method described is that of vacuum depositing a metal layer directly on the die. Despite the Examiner's allegation that there is a point during this process whereat the metallic layer is not imaged or embossed, this physically cannot be the case in view of the following considerations.

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Coates expressly teaches in the summary and detailed description (col. 1, line 55-col. 2, line 4) that the metallic reflecting hologram is prepared by use of a die having a holographic image formed in the embossing surface thereof. In all embodiments taught in Coates, the die used in connection with preparing the metallic reflecting hologram comprises an image thereon. The image is the result of a "pattern of raised areas and valleys which are a holograph of the object being holographed" (col. 1, lines 67-68). Thus, the die comprises an image thereon. At the moment that the metal layer is applied to the die, which occurs via vacuum deposition in the embodiment cited by the Examiner, the metal layer takes the holographic image of the die. As such, Coates does not teach any embodiment wherein the metallic layer is not imaged or embossed.

As neither Coates nor Otaki teach an image-free metallic layer, they do not teach each and every element either alone or in combination. Therefore, withdrawal of the rejection is requested.

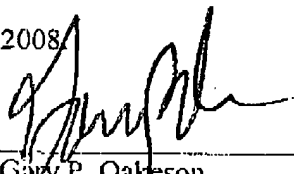
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D. Conclusion

Appellants respectfully submit that the claims on appeal as set forth in the Appendix are patentably distinct from the asserted prior art references. Particularly, the present claims are not obvious over Otaki in view of Coates. The combination of Otaki and Coates does not teach each and every element of the presently claimed invention within the meaning of 35 U.S.C. § 103(a). For this reason, Appellants respectfully requests that the Board of Appeals reverse the rejection and remand the case to the Examiner for allowance.

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